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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,287	04/03/2001	Randall S. Alberte	PHA-009.01	3688

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EXAMINER
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GARCIA, MAURIE E

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/826,287**

Applicant(s)

**Alberte et al**

Examiner  
**Maurie E. Garcia, Ph. D.**

Art Unit  
**1627**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Aug 22, 2001 (Preliminary Amendment).

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-40 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-40 are subject to restriction and/or election requirements.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Supervisory Patent Examiner, at (703) 308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. The Preliminary Amendment filed August 22, 2001 is acknowledged. Claim 1 was amended and no claims were cancelled or added. Claims 1-40 are pending.

#### *Election/Restriction*

2. Please note that in preparing this Restriction Requirement, the examiner noted several problems with the claims. The examiner is noting some of these defects here, since they effect the interpretation of the instant claims and therefore their placement into the groups set forth below. It would assist the further examination of the case on the merits if applicant could correct these problems and/or address these issues in the Response to this action.

3. Claims 24-40 appear to have incorrect dependencies. These claims recite the "method of claim 20 or 21"; however, it appears that they should depend from the "method of claim 21 or 22" (as recited in claim 23). Claims 24-40 have been interpreted as depending from claims 21 or 22 for the purposes of this Restriction Requirement.

4. Also, claims 27, 28 and 32 appear to have extraneous text included in the claim, as a second sentence is included in the body of the claim.

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, drawn to a compound and composition comprising the compound, classified in various classes and subclasses depending on the specific compound structure, for example, class 560, subclasses 1+; class 564, subclasses 1+ or class 568, subclasses 579+.
- II. Claim 20, drawn to a combinatorial library, classified in various classes and subclasses depending on the compounds of the library, for example, class 435, DIG 22-39.
- III. Claims 21 and 23-40 (in part), drawn to a method of inhibiting adhesion, classified in various classes and subclasses, for example, class 436, subclasses 501+ (e.g. 518+, 8+, 25+, etc.).
- IV. Claims 22 and 23-40 (in part), drawn to a method of enhancing adhesion, classified in various classes and subclasses, for example, class 436, subclasses 501+ (e.g. 518+, 8+, 25+, etc.).

6. The inventions are distinct, each from the other because of the following reasons:

7. Groups I and II represent separate and distinct products. They differ in respect to their properties, their use and the synthetic methodology for making them. Therefore, they have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, the library of Group II is a composition comprising at least two members, while Group I represents distinct compounds. Libraries and single compounds also have different uses and require different methods of making.

8. Groups I and III & IV are related as product and process(es) of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the compounds of Group I could be used in other processes of using the product, such as diagnostic agents. Furthermore, the methods of Groups III & IV could be practiced with other compounds (i.e. those not of structure 1).

9. Group II is not related to the methods of Groups III & IV. The inventions are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. In the instant case the library of Group II is not disclosed as being used in either the method of inhibiting adhesion (Group III) or the method of enhancing adhesion (Group IV).

10. Groups III and IV are different methods. The methods are different because they use different steps, require different reagents and/or will produce different results. They therefore have different issues regarding patentability and enablement and represent patentably distinct subject matter. In the instant case, each of the methods has a completely different end result. In fact, the end results are completely opposite, i.e. inhibiting adhesion (Group III) vs. enhancing adhesion (Group IV).

11. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. Please note that even though some of these groups could be classified in the same class/subclass, this has no effect on the non-patent literature search. The different methods and products would require completely different searches in these databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

12. This application contains claims directed to patentably distinct species of the claimed invention for **Groups I - IV**. Election is required as follows.

13. If applicant elects the invention of **Group I**, applicant is required to elect from the following patentably distinct species. Please elect one species from *each* subgroup below. Claims 1 and 19 are generic.

**Subgroup A: Species of X moiety**

- Species 1: bond
- Species 2: O
- Species 3: S
- Species 4: NR'

**Subgroup B: Species of Z moiety**

- Species 1: R
- Species 2: acyl
- Species 3: trialkylsilyl
- Species 4: alkylsulfonyl
- Species 5: fluoroalkylsulfonyl
- Species 6: arylsulfonyl
- Species 7: S(O)<sub>2</sub>OH

Subgroup C: Species of Ar and Ar' moiety\*\*

*\*\* Note that if Ar and Ar' are not identical, then an election for both Ar and Ar' should be made*

Species 1: aryl (with any optional substituents defined)

Species 2: heteroaryl (with any optional substituents defined)

Subgroup D: Species of covalent tether (T)

Species 1: amide

Species 2: ether

Species 3: amine

Species 4: ester

Subgroup E: Species of compound, specific

Finally, a specific compound should be elected for purposes of search, specifically showing all variable groups (all atoms and bonds defined) and their connectivity. The election should result in a single chemical compound.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

14. If applicant elects the invention of **Group II**, applicant is required to elect from the following patentably distinct species. Please elect one species from *each* subgroup below. Claim 20 is generic.

Subgroup A: Species of X moiety

Species 1: bond

Species 2: O

Species 3: S

Species 4: NR'

Subgroup B: Species of Z moiety

Species 1: R

Species 2: acyl

Species 3: trialkylsilyl

Species 4: alkylsulfonyl

Species 5: fluoroalkylsulfonyl

Species 6: arylsulfonyl

Species 7: S(O)<sub>2</sub>OH

Subgroup C: Species of Ar and Ar' moiety\*\*

*\*\* Note that if Ar and Ar' are not identical, then an election for both Ar and Ar' should be made*

Species 1: aryl (with any optional substituents defined)

Species 2: heteroaryl (with any optional substituents defined)

Subgroup D: Species of covalent tether (T)

Species 1: amide

Species 2: ether

Species 3: amine

Species 4: ester

Subgroup E: Species of core compound, specific

Finally, a specific core compound of the library should be elected for purposes of search, specifically showing all variable groups (all atoms and bonds defined) and their connectivity. The election should result in a single core compound of the library.

The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

15. If applicant elects the invention of **Group III**, applicant is required to elect from the following patentably distinct species. Claim 21 is generic.

Species of surface

Applicant is required to elect, for purposes of search, a specific surface from those set forth in claims 23-40.

The species are distinct, each from the other, because their structures and modes of action are different. That is, they differ in their surface reactivity (for adhesion) and differ in the materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

16. If applicant elects the invention of **Group IV**, applicant is required to elect from the following patentably distinct species. Claim 22 is generic.



Species of surface

Applicant is required to elect, for purposes of search, a specific surface from those set forth in claims 23-40.

The species are distinct, each from the other, because their structures and modes of action are different. That is, they differ in their surface reactivity (for adhesion) and differ in the materials from which they are made. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

17. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

18. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and ***a listing of all claims readable thereon***, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

19. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

20. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

21. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

22. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

23. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR

1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00 and alternate Fridays.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number or the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie E. Garcia, Ph.D.  
February 8, 2002

  
**MAURIE E. GARCIA, PH.D.**  
**PATENT EXAMINER**